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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/600,249

06/20/2003

Bronwyn Syiek

35581000003

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23418 7590 01/16/2007  
VEDDER PRICE KAUFMAN & KAMMHOLZ  
222 N. LASALLE STREET  
CHICAGO, IL 60601

EXAMINER

ISMAIL SHAWKI SAIIF

ART UNIT

PAPER NUMBER

2155

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
|--|-----------|---------------|
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3 MONTHS

01/16/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/600,249

Applicant(s)

SYIEK ET AL.

Examiner

Shawki S. Ismail

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 6/20/2003.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. This communication is responsive to the application filed on June 20, 2003. Claims 1-31 are presented for examination.

References in applicant's IDS form 1449 have been considered.

### **Claim Rejections - 35 USC §102**

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

3. Claims 1-31, are rejected under 35 U.S.C. 102(e) as being anticipated by **Prince** U.S. Patent application No. **20040148506A1**.

4. As o claim 1, Prince teaches a method of controlling electronic mail (e-mail) message transmission over a network comprised of:

receiving a first set of encoded e-mail addresses (refer to paragraph 0059);

compiling a second set of encoded e-mail addresses to which an e-mail message should not be sent (refer to paragraph 0030); and

removing from said first set of encoded e-mail addresses, each encoded e-mail address that is in said second set of encoded e-mail addresses thereby yielding a third

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set of encoded e-mail addresses to which an e-mail message may be sent (refer to paragraph 0048).

5. As o claim 2, Prince teaches the method of claim 1 wherein said step of receiving a first set of encoded e-mail addresses includes the step of: receiving a first set of hash coded e-mail addresses (refer to paragraph 0031).

6. As o claim 3, Prince teaches the method of claim 1 wherein said step of receiving a first set of encoded e-mail addresses includes the step of: receiving hash coded e-mail addresses from an e-mail mass mailer (refer to paragraph 0059).

7. As o claim 4, Prince teaches the method of claim 1 further comprised of the steps of: sorting said first set of encoded e-mail addresses into a first ordered list of encoded e-mail addresses wherein said encoded e-mail addresses are in ascending order; sorting said second set of encoded e-mail addresses into a second ordered list of encoded e-mail addresses wherein encoded e-mail addresses are in ascending order; and beginning with a first entry in said first ordered list of encoded e-mail addresses, and beginning with a first entry in said second ordered list, comparing the first entry in said first ordered list to the first entry in said second ordered list then successive entries in said second ordered list, until the value of an entry in said second ordered list equals or exceeds the value of the first entry in said first list; and removing the first entry from said first list upon the detection in said second ordered list of the first entry in said first ordered list, thereby yielding a third set of encoded e-mail addresses to which an e-mail message may be sent ((refer to paragraph 0031 and 0048) .

8. As o claim 5, Prince teaches the method of claim 1 further including the step of: sending said third set of encoded e-mail address to an e-mail mass mailer via a data network (refer to paragraph 0048).

9. As o claim 6, Prince teaches the method of claim 1 further including the step of identifying e-mail address that are encoded in said third set of encoded e-mail addresses (refer to paragraph 0048).

10. Claims 7-31 do not teach or define any new limitation above claims 1-6 therefore, they are rejected for similar reasons

11. Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in its entirety as potentially teaching of all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

### **Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shawki S Ismail whose telephone number is 571-272-3985. The examiner can normally be reached on M-F 8:30 - 5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached at 571-272-4006. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Shawki Ismail  
Patent Examiner  
January 8, 2007



*Bharat Barot*  
**BHARAT BAROT**  
**PRIMARY EXAMINER**